

PATENT

99AB173/ALBRP158US

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence (along with any paper referenced as being attached or enclosed) is being sent via facsimile on the below date to:  
(703) 872-9306, Mail Stop Appeal Brief - Patents, Commissioner for Patents,  
P.O. Box 1450, Alexandria, VA 22313-1450

Date: 2.11.05  
Kelly M. JenkinsRECEIVED  
CENTRAL FAX CENTER

FEB 11 2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:

Applicant(s): Thomas M. Keeley

Examiner: Andre D. Boyce

Serial No: 09/407,664

Art Unit: 3623

Filing Date: September 28, 1999

Title: AUTOMATIC NEGOTIATION WITH VENDOR FOR UPGRADING

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

---

**AMENDED APPEAL BRIEF**

---

Dear Sir:

Applicants submit this Amended Appeal Brief to correct informalities noted in the original Appeal Brief filed on November 19, 2004 in connection with an appeal of the above-identified patent application. Specifically, references to page and line numbers have been added to the summary of independent claim 67. In the event any additional fees may be due, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063.

09/407,664

99AB173/ALBRP158US

**I. Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))**

The real party in interest in the present appeal is Rockwell Automation Technologies, Inc., the assignee of the present application.

**II. Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))**

Appellants, appellants' legal representative, and/or the assignee of the present application are not aware of any appeals or interferences which will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. Status of Claims (37 C.F.R. §41.37(c)(1)(iii))**

Claims 40-79 are pending in the application. The rejection of claims 40-79 is being appealed.

**IV. Status of Amendments (37 C.F.R. §41.37(c)(1)(iv))**

Claim amendments have been made and entered after the Final Office Action.

**V. Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))****A. Independent Claim 40**

Independent claim 40 and its corresponding dependent claims relate to a factory automation system that provides status information for at least one factory automation component. (*See e.g.* Application at page 4, lines 8-10.) The system includes a factory automation component distributed by a first party where the component resides at a site location of a second party. (*See e.g.*, Application at page 4, lines 10-11.) The component periodically communicates status information to a first party, wherein the first party compiles the status information from the component and utilizes the status information to the benefit of the second party. (*See e.g.*, Application at page 4, lines 11-14.) The status information comprises component source information, first party site address information, component type information, second party site information and component health information. (*See e.g.*, Application at page 3, lines 15-27.)

09/407,664

99AB173/ALBRP158US

**B. Independent Claim 50**

Independent claim 50 and its corresponding dependent claims relate to an Internet business communication system. (*See e.g.*, Application at page 4, lines 15-16.) The Internet business communication system includes a website adapted to be employed by a vendor for receiving factory automation component status information over the Internet from a plurality of factory components residing at one or more customer sites. (*See e.g.*, Application at page 4, lines 16-19.) Each component has a different IP address. (*See e.g.*, Application at page 4, lines 19.) The website matches component information residing at the vendor's website with the IP address of the component and provides this information to the vendor. (*See e.g.*, Application at page 4, lines 19-21.) The status information comprises component type information, component health information, customer name information, customer site information and component location information. (*See e.g.*, Application at page 3, lines 15-27.)

**C. Independent Claim 59**

Independent claim 59 and its corresponding dependent claims relate to a method that provides status information to a vendor on at least one factory automation component sold by the vendor to at least one customer. (*See e.g.*, Application at page 4, lines 22-24.) The method includes the steps of locating at least one component at a site of the at least one customer, connecting the at least one component to the vendor, communicating periodically component status information from the at least one component to the server of the vendor, searching a database of the vendor for customer identification information and component location information corresponding to the status information of the at least one component and outputting the customer identification information and component status and location information to the vendor. (*See e.g.*, Application at page 4, line 24-page 5, line 2.) The status information comprises component source address information, vendor site address information, component version information and customer site information. (*See e.g.*, Application at page 3, lines 15-27.)

**D. Independent Claim 67**

Independent claim 67 and its corresponding dependent claim relate to a computer

09/407,664

99AB173/ALBRP158US

memory that stores a periodic status message provided by a factory automation component. (*See e.g.*, Application at page 12, lines 1-9.) This status message includes health information that relates to the factory automation component wherein the factory automation component has an IP address (*See e.g.*, Application at page 13, lines 3-6.)

**E. Independent Claim 69**

Independent claim 69 relates to an Internet business communication system. (*See e.g.*, Application at page 5, lines 3-4.) The Internet business communication system includes means for matching a factory automated component location and customer identification information with status information provided by the factory automated component over the Internet. (*See e.g.*, Application at page 5, lines 4-7.) The status information includes information relating to the health of the component wherein the component is located at a site location of a customer and communicates status information to a site of a vendor. (*See e.g.*, Application at page 5, lines 7-9.) The status information comprises customer site information, customer name information, component type information, vendor site address, component location and component version information. (*See e.g.*, Application at page 3, lines 15-27.)

**F. Independent Claim 70**

Independent claim 70 and its corresponding dependent claims relate to a factory automated component. (*See e.g.*, Application at page 5, lines 21-22.) The factory automated component includes a processor, a memory coupled to the processor and a network interface coupled to the processor for transmitting and receiving data with at least one remote computer system. (*See e.g.*, Application at page 5, lines 22-24.) The factory component communicates status information periodically to the at least one remote computer system. (*See e.g.*, Application at page 5, lines 24-26.) The status information comprises component version information, customer site information, customer name information, vendor site address information and component health information. (*See e.g.*, Application at page 3, lines 15-27.)

09/407,664

99AB173/ALBRP158US

**G. Independent Claim 74**

Independent claim 74 and its corresponding dependent claims relate to a system that monitors factory automated components located at a customer's site electronically. (*See e.g.*, Application at page 5, lines 27-28.) The system includes a central server of a vendor, wherein a plurality of factory automated components are operatively coupled to the vendor server, each of the plurality of factory automated components providing status information related thereto to the vendor server. (*See e.g.*, Application at page 5, line 28-page 6, line 2.) The vendor server is configured to receive the status information from the plurality of different components, and match the status information to customer identification information and component location information of each of the plurality of factory automated components with undesirable status information. (*See e.g.*, Application at page 6, lines 3-6.) The status information comprises component location information, customer site information, vendor site information and component source address information. (*See e.g.*, Application at page 3, lines 15-27.)

**H. Independent Claim 79**

Independent claim 79 and its corresponding dependent claims relate to a system for providing status information to a vendor on at least one factory automation component sold by the vendor to at least one customer. (*See e.g.*, Application at page 6, lines 15-17.) The system includes means for locating at least one component at a site of at least one customer; means for connecting the at least one component to a network connected to a server of the vendor; means for communicating periodically component status information from the at least one component to the server of the vendor; means for searching a database located on the server of the vendor for customer identification information and component location information corresponding to the status information of the at least one component; and means for outputting the customer identification information and component status and location information to the vendor. (*See e.g.*, Application at page 6, lines 17-24.) The status information comprises component type information, customer site information, component version information, component source address information and vendor site address information. (*See e.g.*, Application at page 3, lines 15-27.)

09/407,664

99AB173/ALBRP158US

---

**VI. Grounds of Rejection to be Reviewed (37 C.F.R. §41.37(c)(1)(vi))**

A. Whether claims 40, 42-49, 59, 61-66, 69-70, 72-76, 78 and 79 are anticipated under 35 U.S.C. §102(b) over Ogushi, *et al.* (EPPN 0822473).

B. Whether claims 50, 52-58, 60 and 77 are unpatentable under 35 U.S.C. §103(a) over Ogushi, *et al.* in view of Sekizawa (US 6,430,711).

C. Whether claims 41 and 71 are unpatentable under 35 U.S.C. §103(a) over Ogushi, *et al.* in view of Chamberlin, *et al.* (US 4,703,325).

D. Whether claim 51 is unpatentable under 35 U.S.C. §103(a) over Ogushi, *et al.* in view of Sekizawa in further view of Chamberlin, *et al.*

E. Whether claims 67 and 68 are unpatentable under 35 U.S.C. §103(a) over Ogushi, *et al.* in view of Chamberlin, *et al.* in further view of Sekizawa.

**VII. Argument (37 C.F.R. §41.37(c)(1)(vii))**

A. **Rejection of Claims 40, 42-49, 59, 61-66, 69-70, 72-76, 78 and 79 Under 35 U.S.C. §102(b)**

i. **Claims 40, 42-49, 59, 61-66, 74-76 and 78**

Claims 40, 42-49, 59, 61-66, 74-76 and 78 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ogushi, *et al.* (US 6,385,497). Reversal of this rejection is respectfully requested for at least the following reasons. Ogushi, *et al.* does not teach or suggest the subject invention as recited in claims 40, 42-49, 59, 61-66, 74-76 and 78. A single prior art reference anticipates a patent claim only if it expressly or inherently describes *each and every limitation* set forth in the patent claim. *Trintec Industries, Inc., v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2D 1597 (Fed. Cir. 2002); *See*

09/407,664

99AB173/ALBRP158US

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). The *identical invention* must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 40 (and similarly independent claims 59 and 74) recites a factory automation component that communicates status information to a first party wherein the status information is compiled by the first party and utilized to the benefit of a second party. Such status information comprises component *source information*, vendor site address information, component type information, customer site information and component health information. Ogushi, *et al.* does not teach such claimed aspects of the subject invention.

More particularly, Ogushi, *et al.* does not teach or suggest a factory automation component that *communicates component source information* as recited in claims 40, 59 and 74. The Examiner contends that Ogushi, *et al.* discloses component source information by citing the network location of the "office of a vendor." (See Ogushi, *et al.* col.3, ll.6-9). However, this passage of Ogushi, *et al.* is not directed to the disclosure of component source information *communicated via a factory automation component*, as recited in the subject claims. Instead, Ogushi, *et al.* describes a network of computers, wherein one computer on the network is located at the "office of a vendor." However, stating that the vendor's office is part of a network is merely a *label* employed to designate a computer's location in relation to other computers in such a network. In contrast, as claimed in the subject invention, component source information is *communicated by a factory automation component* to designate the source (*e.g.*, manufacturer, distributor, *etc.*) of such a component. Thus, since Ogushi, *et al.* merely references the *location of the office of a vendor* on a network, it does not teach or suggest a factory automation *component that communicates* source information, as recited in the subject claims.

Moreover, Ogushi, *et al.* does not teach or suggest such component source information *communicated directly to a first party* that distributes the factory automation component for the benefit of the second party, as recited in the subject claims. Instead, Ogushi, *et al.* is *silent with regard to communicating* component source information to a

09/407,664

99AB173/ALBRP158US

first party wherein such information is utilized to the benefit of the second party, as recited in the subject claims. Since vendor information, as disclosed in Ogushi, *et al.* is only employed as a label to locate a party on a network, as noted above, it follows that such information is *not communicated* to any party. Thus, since a second party never receives factory automation component source information under Ogushi, *et al.*, it cannot be employed to benefit a first party, as recited in the subject claims.

The Examiner contends that component source information is communicated since production factories may belong to different manufacturers as disclosed in Ogushi, *et al.* (See Advisory Action dated August 30, 2004 at page 2). The applicant's representative respectfully disagrees. Ogushi, *et al.* does not teach or suggest component source information is communicated from any source, let alone one or more production factories. Ogushi, *et al.* simply points out that such production factories can belong to one or more manufactures, but is silent with regard to the transmission of such information. There is no indication that the "industrial equipments [sic]" transmit anything but the state of equipment in trouble, as taught by Ogushi, *et al.* (See column 3, lines 32-35). Thus, it follows that Ogushi, *et al.* does not teach or suggest component communication that includes component source information, as recited in the subject claims. The Federal Circuit has repeatedly held that in order to reject claims due to anticipation, the prior art reference must not only teach or suggest each and every element of the claimed invention, but such reference must also identically set forth the claimed limitations as recited in the subject claims. See 1-3 Chisum on Patents §3.02[1][b]. See *e.g.*, *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) ("Under 35 U.S.C. §102 every limitation of a claim must *identically appear* in a single prior art reference for it to anticipate the claim."); (emphasis added). See *Novo Nordisk A/S v. Becton Dickinson & Co.*, 96 F. Supp.2d 309, 312 (S.D. N.Y. 2000) ("It is not sufficient that each element be found somewhere in the reference, the elements must be '*arranged as in the claim.*'"); (emphasis added).

For at least the reasons stated in this section, the Examiner has failed to cite prior art that teaches or suggests each and every limitation of the subject claims. In particular, communicating *component source* information from at least one component. Accordingly, the Examiner has failed to establish a case of anticipation pursuant to 35



09/407,664

99AB173/ALBRP158US

U.S.C. §102(b). In view of at least the foregoing, the subject claims are in condition for allowance and it is respectfully requested that the rejection of independent claims 40, 59 and 74 (and the claims that depend there from) be withdrawn.

ii. Claims 59, 61-66, 69, 70 and 72-73

Claims 59, 61-66, 69, 70 and 72-73 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ogushi, *et al.* (US 6,385,497). Reversal of this rejection is respectfully requested for at least the following reasons. Ogushi, *et al.* fails to teach or suggest all of the claim limitations. In particular, communicating component version information from at least one component. Because the cited prior art does not teach or suggest each and every element of the claimed invention as recited in the subject claims, the prior art does not anticipate the claimed subject invention.

Independent claims 59, 69 and 70 recite *communicating* component version information *from at least one component* directly to the server of the vendor, as recited in independent claims 59, 69 and 70. The Examiner contends that Ogushi, *et al.* discloses the serial number of a component. (See Final Office Action, page 6). However, the serial number is not *transmitted from a component* directly to the server of the vendor, as recited in the subject claims. Instead, as disclosed in Ogushi, *et al.*, once a "trouble" is detected, an *operator enters* such information into a computer to be transmitted to a vendor. (See col.6, ll.41-43). In addition, the *serial number* of a component is not the *version number* of a component since the serial number is employed to distinguish one component from another. Thus, the *serial number* does not provide the vendor with *version information*, as recited in the subject claims.

For at least the reasons stated in this section and in Section VII(A)(i) *supra*, the Examiner has failed to cite prior art that teaches or suggests each and every element of the subject claims. In particular, communicating *component version* information from at least one component. Accordingly, the Examiner has failed to establish a case of anticipation pursuant to 35 U.S.C. §102(b). In view of at least the foregoing, the subject claims are in condition for allowance and it is respectfully requested that the rejection of independent claims 59, 69 and 70 (and the claims that depend there from) be withdrawn.

09/407,664

99AB173/ALBRP158US

---

iii. Claim 69

Moreover, Ogushi, *et al.* does not teach or suggest means for matching a factory automated *component location* and customer identification information with status information provided by the factory automated component, as recited in claim 69. The Examiner contends that Ogushi *et al.* discloses means for matching a factory automated *component location* and customer information since “[t]he component location is determined and matched *via* the host computer and then transmitted to the vendor host computer *via* the Internet.” (See Final Office Action, page 21). Applicant’s representative respectfully disagrees. Ogushi *et al.* does not mention *component location* information and further does not mention that “component location information is determined” as the Examiner contends. Instead, Ogushi *et al.* discloses reporting the *state of equipment* in trouble. (See col. 3, ll. 33-36). The *state of the equipment* does not include the *location information* of such equipment, as recited in the subject claims.

For at least the reasons stated in this section and in Section VII(A)(ii) *supra*, the Examiner has failed to cite prior art that teaches or suggests each and every element of the subject claims. In particular, communicating *component location* information from at least one component. Accordingly, the Examiner has failed to establish a case of anticipation pursuant to 35 U.S.C. §102(b). In view of at least the foregoing, the subject claims are in condition for allowance and it is respectfully requested that the rejection of independent claims 59, 69 and 70 (and the claims that depend there from) be withdrawn.

iv. Claim 79

In addition, Ogushi, *et al.* does not teach or suggest means for searching a database including comparing received component information with component information contained in the database, as recited in claim 79. Instead, Ogushi, *et al.* only describes employing a database to look up trouble information. (See col.5, ll.34-48). Further, in Ogushi, *et al.* the database only contains trouble information that has been reported in the past. If a machine has not reported trouble information in the past, the database is empty. In the present invention, searching the database will provide information such as whether product upgrades are available, whether maintenance should

09/407,664

99AB173/ALBRP158US

be scheduled, or that there might be a safety issue or application solution that might be helpful to the customer. (page 3, lines 22-27).

For at least the aforementioned reasons, it is readily apparent that Ogushi, *et al.* does not teach or suggest each and every element of the subject invention as recited in independent claims 40, 59, 69, 70, 74 and 79 (and claims 42-49, 61-66, 72-73, 75-76 and 78 which respectively depend there from). Accordingly, this rejection should be withdrawn.

**B. Rejection of Claims 50, 52-58, 60 and 77 Under 35 U.S.C. §103(a)**

Claims 50, 52-58, 60 and 77 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ogushi, *et al.* (US 6,385,497) in view of Sekizawa (US 6,430,711). Reversal of this rejection is respectfully requested for at least the following reasons. Ogushi, *et al.* and Sekizawa individually and in combination, do not teach or suggest the subject invention as recited in claims 50, 52-58, 60 and 77. To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claim 50 recites an Internet communication system including a website for receiving factory automation component status information from a plurality of components. Such status information comprises component type information, component health information, *customer name information*, customer site information and component location information. Neither Ogushi, *et al.* nor Sekizawa teach or suggest such limitations as recited in the subject claims.

09/407,664

99AB173/ALBRP158US

More particularly, Ogushi, *et al.* does not teach or suggest a website that receives *customer name information* from a plurality of factory components, as recited in claim 50. The Examiner contends that customer name information is disclosed by the factory or host computer information. However, Ogushi, *et al.* does not teach or suggest that customer name information is received from a plurality of factory automation components. Instead, Ogushi, *et al.* discloses providing the state of the equipment in trouble to a vendor and such state of the equipment does not relate to customer name information.

Notwithstanding that the cited references do not make obvious the claimed invention, there is no motivation or suggestion to combine the references in the manner suggested. In order to reject claims in an application pursuant to 35 U.S.C. §103, there must be some logical reason apparent from *positive, concrete evidence* of record, which justifies a combination of primary and secondary references. *See In re Lakowski* 871 F.2d 115; 10 U.S.P.Q.2D (BNA) 1397 (Fed. Cir. 1989) citing *In re Regel*, 526 F.2d 1399, 1403 n.6, 188 USPQ 136, 140 n.6 (CCPA 1975). A challenger to the validity of a patent cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention; the *challenger has the burden to show some teaching or suggestion* in the references to support their use in the particular claimed combination. *See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988).

The Examiner contends that motivation to combine the cited references exists since "it would have been obvious to one of ordinary skill in the art...to include each component having a different IP address, the website matching component information in Ogushi, *et al.* as seen in Sekizawa, thereby efficiently identifying the machines and their corresponding problems" since both Ogushi, *et al.* and Sekizawa are concerned with effective monitoring of machines *via* a computer network. *See* Final Office Action (dated May 17, 2004), pages 15-16. However, neither Ogushi, *et al.* nor Sekizawa mention, and the Examiner has not cited the "efficient identification of machines and their corresponding problems" as motivation to combine in either Ogushi, *et al.* or Sekizawa. Thus, the Examiner has failed to meet his burden to show some teaching or suggestion in

09/407,664

99AB173/ALBRP158US

either of the cited references to support their use in the combination, as recited in the subject claims.

In addition, there is no motivation to combine Ogushi, *et al.* with Sekizawa, as Sekizawa is non-analogous to Ogushi *et al.*, since it does not relate to factory automation components, as recited in the subject claims. Instead, Sekizawa relates to a plurality of network printers in a business environment. There is no mention in Ogushi, *et al.* of utilizing network printers and there is no mention in Sekizawa of factory automation components or the art of factory automation. Thus, since Sekizawa is concerned with the non-analogous art of network printers and does not contemplate factory automation, there is no motivation to combine Ogushi, *et al.* with Sekizawa and such a combination is improper. The mere fact that references can be modified does not render the modification obvious unless the *cited art also suggests* the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Moreover, nowhere does Sekizawa mention the use of IP addresses in conjunction with the factory automation components disclosed in Ogushi, *et al.* Similarly, there is no mention in Ogushi, *et al.* of utilizing IP addressing with a factory automation system that provides component status information, as recited in the subject claims. It is readily apparent that the Examiner has not met the requisite burden to show proper motivation to combine Ogushi, *et al.* with Sekizawa. The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the patent or application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation, which is not the standard with which obviousness is determined. *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hodosh v. Block Drug*, 786 F.2d at 1143 n. 5., 229 USPQ at 187 n. 4.; *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1985).

It appears the Examiner is impermissibly employing 20/20 hindsight with applicants' specification as a roadmap to make the purported combination. The rationale proffered to modify and combine Ogushi, *et al.* and Sekizawa is to achieve benefits

09/407,664

99AB173/ALBRP158US

identified in applicants' specification, which overcome problems associated with conventional systems and/or methods. Applicants' representative respectfully submits that this is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. This sort of rationale has been condemned by the Court of Appeals for the Federal Circuit. *See, for example, Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

In view of at least the foregoing, it is readily apparent that there is no suggestion or motivation to combine Ogushi, *et al.* and Sekizawa and even as combined in the manner suggested do not make obvious the subject invention as recited in independent claim 50 (and claims 52-58, 60 and 77 which respectively depend there from). Accordingly, this rejection should be withdrawn.

**C. Rejection of Claims 41 and 71 Under 35 U.S.C. §103(a)**

Claims 41 and 71 stand rejected under 35 USC §103(a) as being unpatentable over Ogushi, *et al.* (US 6,385,497) in view of Chamberlin, *et al.* (US 4,703,325). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Claims 41 and 71 depend from independent claims 40 and 70 respectively and Chamberlin, *et al.* fails to make up for the aforementioned deficiencies of Ogushi, *et al.* This is with respect to monitoring the health of each industrial component on a periodic basis, using a direct means of communicating with the industrial component and assigning a unique IP address to each industrial component. For the above-mentioned reasons, it is submitted that neither Ogushi, *et al.* nor Chamberlin, *et al.* make obvious claims 41 and 71. Accordingly, withdrawal of this rejection and allowance of claims 41 and 71 is respectfully requested.

**D. Rejection of Claim 51 Under 35 U.S.C. §103(a)**

Claim 51 stands rejected under 35 USC §103(a) as being unpatentable over Ogushi, *et al.* (US 6,385,497) in view of Sekizawa (US 6,430,711) in further view of Chamberlin, *et al.* (US 4,703,325). It is respectfully submitted that this rejection should

09/407,664

99AB173/ALBRP158US

be withdrawn for at least the following reasons. Claim 51 depends from independent claim 50 and Sekizawa in combination with Chamberlin, *et al.* fail to make up for the aforementioned deficiencies of Ogushi, *et al.* Accordingly, withdrawal of this rejection and allowance of claim 51 is respectfully requested.

**E. Rejection of Claims 67 and 68 Under 35 U.S.C. §103(a)**

Claims 67 and 68 stand rejected under 35 USC §103(a) as being unpatentable over Ogushi, *et al.* (US 6,385,497) in view of Chamberlin, *et al.* (US 4,703,325) in further view of Sekizawa (US 6,430,711). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Ogushi, *et al.* and Chamberlin, *et al.* individually or in combination do not teach or suggest all the limitations of the subject claims. In addition, there is no motivation to combine Ogushi, *et al.* and Chamberlin, *et al.* with Sekizawa.

In particular, neither Ogushi, *et al.* nor Chamberlin, *et al.* teach or suggest a status message including health information relating to the factory automation component, as defined in the specification of the application. Rather, both cited references are only directed to sending trouble information or error codes. Further, neither Ogushi, *et al.* nor Chamberlin, *et al.* teach or suggest the factory automation component having an IP address. Rather, IP addresses associated with each factory automation component are absent from both references.

Additionally, there is no motivation to combine Ogushi, *et al.* and Chamberlin, *et al.* with Sekizawa, as Sekizawa is non-analogous to both Ogushi, *et al.* and Chamberlin, *et al.* since it does not relate to factory automation components as recited in the subject claims. Instead, Sekizawa relates to a plurality of network printers in a business environment. There is no mention in either Ogushi, *et al.* or Chamberlin, *et al.* of utilizing network printers and there is no mention in Sekizawa of factory automation components or the art of factory automation. Thus, since Sekizawa is concerned with the non-analogous art of network printers and does not contemplate factory automation, there is no motivation to combine Ogushi *et al.* and Chamberlin, *et al.* with Sekizawa and such a combination is improper. The mere fact that references can be modified does not

09/407,664

99AB173/ALBRP158US

render the modification obvious unless the *cited art also suggests* the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).


Accordingly, the combination of Ogushi, *et al.*, Chamberlin, *et al.* and Sekizawa do not make obvious claim 67 and additionally, there is no motivation to make such a combination. Withdrawal of this rejection and allowance of claim 67 and claim 68, which depends there from, are respectfully requested.

F. Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 40-79 be reversed.

A credit card payment form is filed concurrently herewith in connection with all fees due regarding this document. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063.

Respectfully submitted,  
AMIN & TUROCY, LLP

  
John M. Ling  
Reg. No. 51,216

AMIN & TUROCY, LLP  
24<sup>th</sup> Floor, National City Center  
1900 East 9<sup>th</sup> Street  
Telephone: (216) 696-8730  
Facsimile: (216) 696-8731



09/407,664

99AB173/ALBRP158US

---

**VIII. Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))**

40. A factory automation system for providing status information on at least one factory automation component, comprising:

a factory automation component distributed by a first party;

the component residing at a site location of a second party; and

the component communicating status information directly to the first party

wherein the first party compiles the status information from the component and utilizes the status information to the benefit of the second party, the status information comprises component source information, first party site address information, component type information, second party site information and component health information.

41. The system of claim 40, wherein the status information is periodically communicated by the component directly to the first party.

42. The system of claim 40, wherein the first party is a vendor and/or service supplier of the component.

43. The system of claim 40, wherein the second party is a purchaser of the component and the site location is a factory of the purchaser where the component resides.

44. The system of claim 40, wherein the component communicates component health information to the first party from the location site of the second party.

45. The system of claim 44, wherein the health information is selected from the group consisting of a component failure, a component degradation and a component out of calibration.

09/407,664

99AB173/ALBRP158US

46. The system of claim 44, wherein the site of the first party communicates patch information to the component in response to health information from the component.

47. The system of claim 40, wherein the component includes a self diagnosis device.

48. The system of claim 40, wherein the server site of the first party communicates version upgrade information to the component in response to version information from the component that does not correspond to the latest version.

49. The system of claim 40, wherein the server site of the first party transmits a signal to the component in response to status information from the component that initiates an action by the component.

50. An Internet business communication system, including:  
a website adapted to be employed by a vendor for receiving factory automation component status information over the Internet directly from a plurality of factory components residing at one or more customer sites, each component having a different IP address, the website matching component information residing at the vendor's website with the IP address of the component and providing this information to the vendor, the status information comprises component type information, component health information, customer name information, customer site information and component location information .

51. The system of claim 50, wherein the factory automation component status information is periodically received by the vendor.

09/407,664

99AB173/ALBRP158US

52. The system of claim 50, wherein the status information includes the component's health information, such that the vendor can communicate to a customer that one of the plurality of components in the one or more customer sites require attention by the customer.

53. The system of claim 50, wherein the status information includes the component's version information, such that the facilitator can communicate to a customer that one of the plurality of components in the one or more customer sites require a version update.

54. The system of claim 50, wherein the status information includes customer identification information, customer site information and the component location within the customer's site.

55. The system of claim 50, wherein the component information includes customer identification information, customer site information and the component location within the customer's site.

56. The system of claim 50, wherein the status information includes component health information and the website can communicate patch information to at least one of the plurality of components in response to component health information.

57. The system of claim 50, wherein the status information includes the component version information, such that the website can communicate version upgrade information to at least one of the plurality of components in response to component version information.

58. The system of claim 50, wherein the website transmits a signal to at least one of the plurality of components in response to status information from the component that initiates an action to the component.

09/407,664

99AB173/ALBRP158US

59. A method of providing status information to a vendor on at least one factory automation component sold by the vendor to at least one customer, comprising the steps of:

locating at least one component at a site of at least one customer;

connecting the at least one component to a network connected to a server of the vendor;

communicating component status information from the at least one component directly to the server of the vendor, the status information comprises component source address information, vendor site address information, component version information and customer site information;

searching a database located on the server of the vendor for customer identification information and component location information corresponding to the status information of the at least one component; and

outputting the customer identification information and component status and location information to the vendor.

60. The method of claim 59, wherein the status information includes an IP address associated with the component and the step of searching includes matching the customer identification information and component location information corresponding to the IP address included in the status information.

61. The method of claim 59, further including the step of communicating a signal to the at least one component from the server in response to the component status information that initiates an action to the at least one component.

62. The method of claim 59, wherein the server determines if the at least one component has enabled the at least one component to receive communication from the server.

63. The method of claim 59, wherein the status information includes component health information of the at least one component.

09/407,664

99AB173/ALBRP158US

64. The method of claim 63, wherein the server communicates patch information to the component in response to health information from the component.

65. The method of claim 59, wherein the status information includes version information of the at least one component.

66. The method of claim 65, wherein the server communicates version upgrade information to the at least one component in response to version information from the at least one component that does not correspond to the latest version.

67. A computer memory, comprising:  
a periodic status message provided by a factory automation component, the status message including health information relating to the factory automation component, the factory automation component having an IP address.

68. The computer memory of claim 67, further comprising a vendor website which matches the IP address of the component with customer identification information and component location information.

69. An Internet business communication system, including:  
means for receiving factory automated component status information directly from a factory automated component over the Internet, the status information comprises customer site information, customer name information, component type information, vendor site address, component location, and component version information; and  
means for matching a factory automated component location and customer identification information with status information provided by the factory automated component over the Internet, the status information including information relating to the health of the component wherein the component is located at a site location of a customer and communicates status information to a site of a vendor.

09/407,664

99AB173/ALBRP158US

70. A factory automated component, comprising:  
a processor;  
a memory coupled to the processor; and  
a network interface coupled to the processor for directly transmitting and receiving data with at least one remote computer system, wherein the factory component communicates status information to the at least one remote computer system, the status information comprises component version information, customer site information, customer name information, vendor site address information and component health information.

71. The component of claim 70, wherein the status information is communicated periodically and includes health information related to the health of the component.

72. The component of claim 70, wherein the processor includes a self diagnosis device.

73. The component of claim 70, wherein the component includes an enabled mode for receiving communication from the at least one computer and a disabled mode blocking communication from at least one computer.

74. A system for monitoring factory automated components electronically, comprising:

a central server adapted to receive status information directly from one or more factory automated components located at one or more customer sites, the central server being located at a site of a vendor, wherein the server is configured to match component status information to customer identification information and component location information of the one or more factory automated components and output this information to the vendor, the status information comprises component location information, customer site information, vendor site information and component source address information.

09/407,664

99AB173/ALBRP158US

---

75. The system of claim 74; wherein the status information includes the components version information, such that the server can communicate to a customer that one or more components require a version update.

76. The system of claim 74, wherein the server transmits a signal to the one or more components *via* the at least one remote computer in response to status information from the component that initiates an action to the component.

77. The system of claim 74, wherein the server hosts a website of the vendor and the server matches the component status information with the customer identification information and component location information by using an IP address associated with the component.

78. The system of claim 74, wherein the status information includes the components health information, such that the vendor can communicate to a customer that the one or more components in the one or more customer sites require attention by the customer.

09/407,664

99AB173/ALBRP158US

79. A system for providing status information to a vendor on at least one factory automation component sold by the vendor to at least one customer, comprising:

means locating at least one component at a site of at least one customer;

means for connecting the at least one component to a network connected to a server of the vendor;

means for communicating component status information from the at least one component directly to the server of the vendor, the status information comprises component type information, customer site information, component version information, component source address information and vendor site address information;

means for searching a database located on the server of the vendor for customer identification information and component location information corresponding to the status information of the at least one component; and

means for outputting the customer identification information and component status and location information to the vendor.

**IX. Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))**

None.

**X. Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))**

None.